



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
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Washington, DC 20231

MAY 24 2001

RJH
Paper No. 19

In re Application of:
PRICE, DAVID H.
Serial No.: 08/951,188
Filed: October 15, 1997
For: P-TEFB Compositions, Methods and
Screening Assays

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.181, filed November 17, 2000, to withdraw the finality of the October 11, 2000 Office action.

On January 9, 2000, a final rejection was mailed to applicant. On February 3, 2000, applicant filed a letter requesting withdrawal of the finality of the January 9, 2000 Office action. On October 11, 2000, another final rejection was mailed to applicant. In that Office action, the examiner said: "Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Accordingly, this Office action is now made final." The rest of the Office action was a repeat of the January 9, 2000 Office action. On November 17, 2000, the present petition was filed. Subsequent to November 17, 2000, Robert Hill, Quality Assurance Specialist of Technology Center 1600, contacted applicant's representative, Dr. Shelley Fussey, and indicated that the status of the application was not known. Specifically, Mr. Hill indicated that withdrawal of finality of the January 9, 2000 Office action would not have relieved applicant of his responsibility to respond to that Office action in a timely manner and since no response was filed, the application may be abandoned. Mr. Hill indicated that he would speak with the examiner to find out what he said to Dr. Fussey regarding responding to the January 9, 2000 Office action. Mr. Hill also indicated that there was no need to respond to the October 11, 2000 Office action until the status of the application was resolved. In a letter filed on April 13, 2001, Dr. Fussey provided her account of what happened in this application. Mr. Hill discussed the situation with the examiner who did indicate that during the pendency of the application following the January 9, 2000 Office action, he told Dr. Fussey that the finality of that Office action would be withdrawn and that he would send another Office action. (The examiner did not realize at the time that there was no need to send another Office action; only the finality of the January 9, 2000 Office action needed to be removed.)


Based on the record of this case as set forth above and coupled with the April 13, 2001 letter, it is clear that there was confusion on applicant's part as well as on the examiner's part as to whether

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applicant was required to respond to the January 9, 2000 Office action. In view of this confusion, it is fair and reasonable in this case not to hold the application abandoned for failure to respond to the January 9, 2000 Office action. Furthermore, in view of the fact that there was confusion as to the status of the application following the October 11, 2000 Office action, it is fair and reasonable in this case not to hold the application abandoned for failure to respond to the October 11, 2000 Office action. Consequently, this application is considered by the Office to be properly pending at this point in time.

Lastly, applicant has not yet had the chance to respond to the Office action of January 9, 2000, repeated on October 11, 2000. Therefore, the finality of the October 11, 2000 Office action is hereby withdrawn and ~~the time for responding to that Office action is hereby reset to expire three~~ (3) months from the date of this decision. Failure to respond to that Office action within this period for response will cause the application to become abandoned. (35 U.S.C. §133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

PETITION GRANTED.


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